

REMARKS

At the time of the Office Action, claims 1–22 were pending. In the Office Action:

- Claims **1–3, 5–7, 12, and 21** stand rejected under **35 U.S.C. § 103(a)** as being obvious over **Kerai**, U.S. Patent Pub. No. 2002/0005707 in view of **Nishimura** (U.S. Patent Pub. No. 2002/0171755);
- Claims **4, 13, 15–18, and 20** stand rejected under **35 U.S.C. § 103(a)** as being obvious over **Kerai**, in view of **Nishimura**, and **Fischer**, U.S. Patent No. 6,946,817;
- Claims **8–11 and 22** stand rejected under **35 U.S.C. § 103(a)** as being obvious over **Kondo**, U.S. Patent No. 6,151,652 in view of **Nishimura** and **Watanabe** (U.S. Patent Pub. No. 2003/0025823);
- Claim **14** stands rejected under **35 U.S.C. 103(a)** as being obvious over **Kerai** in view of **Nishimura**, **Fischer**, and **Odaohhara**, U.S. Patent No. 6,424,123; and
- Claim **19** stands rejected under **35 U.S.C. 103(a)** as being obvious over **Kerai** in view of **Nishimura**, **Fischer**, and **Hsu**, U.S. Patent No. 6,798,173.

The use of reference characters in describing the presently claimed elements below is for illustrative and exemplary purposes only, and is not to be construed as limiting absent an express indication for doing so.

Applicants thank the Examiner and his supervisor for the courtesy extended in a telephone interview conducted on June 15, 2009, in which the differences between the claimed inventions and the art cited in the Office Action were discussed. The Examiner and his supervisor suggested that the applicants submit the arguments below for further consideration by the Examiner as a way of overcoming the rejections in the Office Action. Applicants therefore formally submit these arguments for consideration.

35 U.S.C. §103(a) Obviousness of Claims 1–3, 5–7, 12, and 21 by Kerai in View of Nishimura

1. The combination of Kerai and Nishimura fail to teach or suggest independent claim 1 since the combination fails to teach or suggest a charger control portion that receives a battery type selection signal from the main controller.

In the prior Office Action, the Examiner had rejected claim 1 under 35 U.S.C. § 103 over the combination of Kerai and Freeman. In the present Office Action, the Examiner, on pp. 3–5, the Examiner replaced the Freeman reference with the Nishimura reference, thus rejecting claim 1 over the combination of Kerai and Nishimura.

The Examiner acknowledged, on p. 4, that:

Kerai does not disclose a charger control portion electrically connected with the main controller, the charger control portion generating charge control signals at one or more outputs according to a battery type selection signal that is output from the main controller and received at an input of the charger control portion, the battery type selection signal distinguishing the battery type of a battery installed in the portable electronic device from a plurality of possible battery types that can be installed in the portable electronic device, wherein differing battery types have differing battery charge characteristics.

The Examiner then provided Nishimura as teaching the element lacking in Kerai, stating, on p. 4:

However, Nishimura discloses a charger control portion (a battery property judging circuit 47, Fig 3) electrically connected with the main controller, the charger control portion generating charge control signals at one or more outputs according to a battery type selection signal that is output from the main controller and received at an input of the charger control portion; the battery type selection signal distinguishing the battery type of a battery installed in the portable electronic device from a plurality of possible battery types that can be installed in the portable electronic device, wherein differing battery types have differing battery charge characteristics ([0033]–[0035], Nishimura).

The Examiner is thus equating Nishimura's battery property judging circuit 47 with the claimed charge control portion. Applicants respectfully disagree with this characterization, because Nishimura's battery property judging circuit 47 does not control anything—and particularly not the battery charging.

The battery property judging circuit 47 of Nishimura determines a property of the battery 18 loaded into a digital camera [0033]. The reason for this is that the algorithms for operation of the camera depend on the type of battery and/or a remaining amount of the battery [0011]. If the battery type is a large capacity battery or the battery has a large remaining amount, then the camera is operated in a normal way. Conversely, if the battery type is a small capacity battery and/or the battery has a small remaining amount of the battery, then the camera is operated in a power-saving way. [0012]

The battery property judging circuit 47 makes this determination by measuring a battery voltage before and while the autofocus motor is driven and the difference between these two voltages is used to determine the type of battery [0036]. It then communicates the battery type information to the CPU 28, and the CPU decides whether to execute the normal operation sequence or the power-saving operation sequence [0036].

Therefore, Nishimura's battery property judging circuit 47 in no way controls any operation related to a charging of the battery—its purpose is simple: read two voltages of the battery at two different times and determine a battery type. For this reason alone, it is not proper for the Examiner to read Nishimura's battery property judging circuit 47 on the claims charger control portion of the present invention.

However, even if *arguendo* the battery property judging circuit 47 could be equated with the claimed charge control portion, Nishimura's handling of battery type information is just the opposite of what is required by claim 1. In claim 1, the main controller outputs the battery type selection signal to the charger control. This is done so that the charger control knows how to properly charge the battery. In Nishimura, the main controller inputs the battery type from the "charger control portion". This is done so that the main processor knows whether to operate the camera in a normal or a power-saving mode—it has nothing to do with charging the battery, but rather with camera operation.

Thus, in addition to Nishimura's battery property judging circuit 47 not properly reading on the claimed charger control portion, the claimed element/relationship of the main controller outputting the battery type selection signal cannot be found in Nishimura as well.

MPEP § 2143.03, and appertaining case law, indicates that in establishing a prima facie case of obvious, all claim limitations must be considered. This section, citing *In re Wilson*, states:

All words in a claim must be considered in judging the patentability of that claim against the prior art.

In the present case, the Examiner has ignored the “charge control” language used in the claim when equating Nishimura’s battery property judging circuit 47 to the claimed charger control portion, and has also ignored the language that the main controller outputs the battery type selection signal and that this is received at an input of the charger control portion.

2. *The combination of Kerai and Nishimura fail to teach or suggest independent claim 12 since the combination fails to teach or suggest a USB battery charger enclosed within the second connector.*

In the Office Action, on p. 6, the Examiner rejected claim 12 over the combination of Kerai and Nishimura. The Examiner stated, in relevant part, that Kerai discloses:

...a USB battery charger (a battery charger control circuit 19, Fig 2) enclosed within the second connector (plug 3 or 4, Fig 1, i.e. connector 22, Fig 2), the USB battery charger including a charging portion that communicates with the device controller for receiving at least one signal relative to the battery, the charging portion adjusting power received from the USB receptacle relative to the at least one signal for charging the battery ([0024]–[0028]).

Applicants do not disagree with the Examiner in characterizing that Kerai shows a battery charger control circuit 19 in Figure 2, and that Kerai discloses a USB plug 3, 4 in Figure 1. Applicants find no teaching whatsoever that Kerai’s battery charger control circuit 19 is located within the second connector (3 or 4) of the USB cable. To the contrary, Kerai teaches that the charger control circuit is included in the telephone. Kerai states, at [0024]:

A battery charger control circuit 19 is also included in the telephone 14. This circuit 19 delivers power to the rechargeable battery 15.

Again, the Examiner has failed to show how this claimed feature is present in the prior art.

For these reasons, Applicants assert that the Examiner has failed to establish a prima facie case of obviousness with respect to independent claims 1 and 12, and for all claims that depend therefrom by virtue of the dependence. Applicants respectfully request that this 35 U.S.C. § 103 rejection be withdrawn from the application.

35 U.S.C. §103(a) Obviousness of Claims 8–11 and 22 by Kondo in View of Nishimura and Watanabe

3. The combination of Kondo, Nishimura, and Watanabe fail to teach or suggest independent claim 8 since the combination fails to teach or suggest a separate digital camera controller and a USB charger that includes a control portion to generate charge control signals.

In the Office Action, on pp. 9–11, the Examiner rejected independent claim 8 as being obvious over the combination of Kondo, Nishimura, and Watanabe (Applicants presume that the references to Kerai in the bottom carryover paragraph on p. 9 and second full paragraph of p. 10 are erroneous and should be references to Kondo—clarification is requested if Applicants' presumptions are incorrect).

On p. 9, with regard to the teaching of Kondo, the Examiner indicated:

Regarding claim 8, Kondo discloses a digital camera (digital camera 1, Fig 1) connected to a computer (a computer 3, Fig 1) by USB to charge a battery by receiving power from the computer through USB (USB interface cable 4, Fig 1), the digital camera comprising:

- a digital camera controller (CPU 12, Fig 1); and
- a USB charger including a USB controller (power supply control circuit 14, Fig 1) to transmit and receive data through a USB port of the computer (3), a control portion (CPU 12, Fig 1) to generate charge control signals corresponding to battery type selection signal, a charging portion (charging circuit 143, Fig 8) electrically connected with the control portion (12) (4:1-18 and 6:21-28).

Applicants respectfully assert that the elements of Kondo are not being properly read on the indicated elements of claim 8.

Claim 8 requires both a digital camera controller, as well as a control portion that is a part of a USB charger. The Examiner has read Kondo's CPU 12 on the claimed digital camera controller, but then has also read CPU 12 on the claimed control portion that is a part of the USB

charger (which the Examiner has equated to the power supply control circuit 14 in Figure 1 of Kondo).

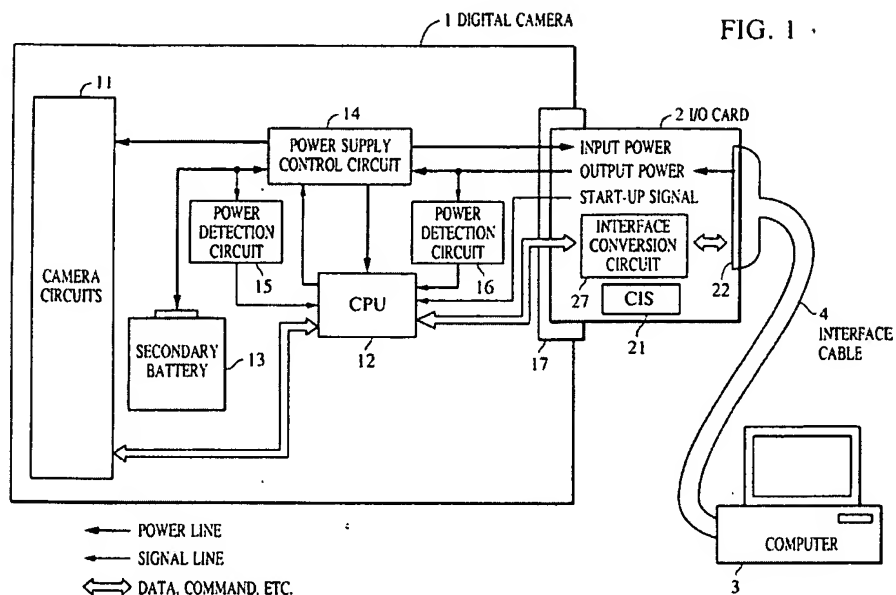


Figure 1 of Kondo

As can be clearly seen in Figure 1 of Kondo, it is impossible for the claimed USB control portion to be a part of the USB charger if the elements are as the Examiner has equated them: the USB charger being element 14 of Kondo, and the USB control portion being the CPU 12. This is particularly true given that the Examiner has also equated the separately claimed digital camera controller with Kondo's CPU 12 as well.

Thus, the Examiner has again ignored the claimed relationship between the elements, thereby not considering all claimed words in judging the patentability of the claim, in contradiction of MPEP § 2143.03 and cited case law.

For these reasons, Applicants assert that the Examiner has failed to establish a prima facie case of obviousness with respect to claim 8, and for all claims that depend therefrom by virtue of the dependence. Applicants respectfully request that this 35 U.S.C. § 103 rejection be withdrawn from the application.

35 U.S.C. §103(a) Obviousness of Claims 4, 8–11, 13–19, 20, and 22 over some combination of Kerai, Nishimura, Fischer, Watanabe, Kondo, Odaohhara, and Hsu

4. Applicants rely upon the above arguments with respect to the remaining dependent claims, and assert that none of the additional references supplants the deficiencies identified above with respect to Wiener.

In the Office Action, on pp. 7–13, the Examiner combined Kerai, Nishimura, Kondo, and Watanabe with numerous other references in establishing an obviating combination of references for various dependent claims in the present application. Without addressing the specifics of the additional references on the merits, Applicants rely upon the above arguments and asserts that the disclosures of each of these additional references, alone or in combination, does not serve to solve the deficiencies of the previously discussed references. The Examiner has cited these references for purposes related to the specifics of the dependent claims.

For these reasons, Applicant asserts that the claim language clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw these 35 U.S.C. § 103 rejections from the present application.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/carrie a. beyer/

Brian C. Rupp, Reg. No. 35,665
Mark Bergner, Reg. No. 45,877
Carrie A. Beyer, Reg. No. 59,195
DRINKER BIDDLE & REATH LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606-1698
(312) 569-1000 (telephone)
(312) 569-3000 (facsimile)
Customer No.: 08968

Date: June 26, 2009
CH01/ 25326246.1